

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

SEP 21 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN HAUPT,
FRANZ KLETZL and ROBERT NEMETH

Application No. 09/090,035

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on September 2, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On November 24, 2003, an Order Returning Undocketed Appeal to Examiner was mailed (Paper No. 32) which requested that the examiner:

1. correct entry and proper numbering of claims 19 and 20 (as is presented in Paper No. 20) to claims 20 and 21;
2. resubmi[t] a Supplemental Appeal Brief and Appendix to include these currently newly numbered claims by appellants;
3. vacat[e] the original Examiner's Answer (Paper No. 29) by the examiner;
4. prepar[e] a new Examiner's Answer with correct numbering for claims 1, 3 through 18 and 20 through 21.

Appellants filed a Supplemental Appeal Brief on February 9, 2004 (Paper No. 34) in response to an Office communication mailed January 2, 2004 (Paper No. 33) requesting that appellants submit a Supplemental Appeal Brief and Appendix with correctly numbered claims. On March 17, 2004, the examiner mailed an Examiner's Answer (Paper No. 35) which "replaces the Examiner['s] Answer paper #29" (page 1). On May 19, 2004, appellants filed a Supplemental Reply Brief (Paper No. 36), which was noted by the examiner on June 8, 2004 (Paper No. 37).

Section 1208 (8th Edition, August 2001) of the Manual of Patent Examining Procedure (MPEP) states:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

The communication mailed March 17, 2004 (Paper No. 35) does not comply with the above requirement.

In addition, Section 1208 of the MPEP further states:

(10) Grounds of Rejection. For each ground of rejection applicable to the appealed claims, an explanation of the ground of rejection, or reference to a final rejection or other single prior art for a clear exposition of the rejection.

While it is noted on page 3 of the Examiner's Answer mailed March 14, 2004 (Paper No. 35) that "[c]laims 1, 3-12, 20 and 21 are rejected," claim 20 is not included in a ground of rejection, nor "reference[d] to a final rejection or other single prior art for a clear exposition of the rejection." Correction is required.

Accordingly, it is

ORDERED that the application is returned to the
Examiner:

1. for issuance of a Supplemental Examiner's Answer
which includes (1) a proper response to the "References of
Record" and (2) inclusion of claim 20 in a ground of rejection;
and

2. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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By:



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